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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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666 FIFTH AVE				
NEW YORK, NY 10103-3198				
EXAMINER				
LEADER, WILLIAM T				
ART UNIT		PAPER NUMBER		
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04/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/781,973

Applicant(s)

OSTROVSKY, ILYA

Examiner

WILLIAM T. LEADER

Art Unit

1795

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 4, 2008, has been entered.
2. The amendment filed on January 28, 2008, has been entered. Claims 63-74 are pending.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

4. Claims 63-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (6,916,414) in view of Schaedel (4,152,221) or Honda et al (6,690,573), newly cited, or Covino (4,861,440), newly cited, and further in view of the Lowenheim text Electroplating.

5. The Dolan patent is directed to a process for anodizing light metals such as aluminum and magnesium (column 1, lines 15-16). The process includes the steps of providing the light metal article, placing the article as an anode in an anodizing solution, providing a cathode electrode in the solution and passing an electric current between the article and the cathode electrode. See column 2, lines 46-56. These steps correspond to the process steps recited in instant claims 63-66. The anodizing solution may comprise a water-soluble phosphorus oxysalt and/or water-soluble alkali metal hydroxides (column 2, lines 25-45). In one embodiment, the solution contains a phosphate and/or a soluble amine such as an alkanolamine. The pH of the anodizing solution is neutral to basic, preferably about 7.1 to 12. See column 4, line 63 to column 5, line 27. Thus, Dolan teaches all constituents of the bath recited in instant claims 63-66 except for a surfactant. With the solution of Dolan, the generation of a sustained plasma (visible light emitting discharge) during anodization may be attained using a pulsed DC voltage in some instances of no more than 80 volts. See column 5, lines 28-35.

6. As noted above, claim 63 differs from the process of Dolan by reciting the inclusion of at least one surfactant. The Schaedel patent is directed to an anodizing process. Schaedel teaches the inclusion of a surfactant in the anodizing solution to form an oxygen-holding foam around the part being anodized. See the abstract. The Honda et al patent is directed to a method for producing an aluminum

electrolytic capacitor, and discloses that it is known to anodize aluminum anode foil (column 1, lines 12-15). Honda et al teaches that a surfactant has been added for the purpose of increasing a spark generating voltage of an electrolytic solution, and improving anodizing performance (column 1, lines 39-42). The Covino patent is directed to the electrolytic formation of an aluminum oxide surface by anodizing. See the abstract. Covino teaches that a conventional wetting agent (surfactant) can be added to the anodizing bath (column 3, lines 47-51). An outer layer of silicone may be applied to the aluminum oxide (column 1, lines 40-46).

7. The Lowenheim text teaches that wetting agents (surfactants) are used to reduce the surface tension of water (pages 520-521). Lowenheim also teaches that surfactants are used to promote disengagement of bubbles on a surface being electrolytically treated (page 135).

8. The prior art of record is indicative of the level of skill of one of ordinary skill in the art. It would have been obvious at the time the invention was made to have included a surfactant in the anodizing solution of Dolan as taught by Schaedel, or Honda et al or Covino because the solution would have made better contact with the article being anodized as shown by the Lowenheim text.

9. With respect to claim 67, Dolan discloses that direct current is preferably used, although alternating current may also be used (column 4, lines 7-11). As indicated above, Dolan teaches that the article is made the anode. With respect to

claim 68, Dolan discloses that the article is subjected to a cleaning and/or degreasing step before being subjected to anodic treatment (column 9, lines 26-28). With respect to claim 69, Dolan discloses that after cleaning the article is preferably rinsed with water (column 9, lines 33-34). With respect to claim 70, current density is a result-effective variable. Choice of an appropriate current density to achieve a desirable anodized coating would have been a matter of routine optimization in accordance with the teaching of Dolan. With respect to claim 71, Dolan discloses that the anodizing solution is preferably maintained at a temperature between about 5 and 90 °C. This range significantly overlaps that recited by applicant. Choice of values from within the range disclosed by Dolan would have been obvious. With respect to claim 72, in examples 1-4 Dolan discloses that the rate of film deposition was approximately 10-15 microns per minute, and that current was applied for approximately 2 minutes. This would give a thickness of 20-30 microns. In example 5, a coating of 2.5 microns was produced. These values fall within the range recited by applicant. Instant claim 73 recites an additional coating. Dolan discloses that the protective coatings produced on the surface of the light metal article may, after anodization, be subjected to further treatments such as painting, sealing, and the like. New claim 74 is considered further limit the electroless deposited metal recited in the Markush group of claim 73 to a nickel rich coating,

thus limiting the scope of the Markush group. Elements of the Markush group, such as paint, are suggested by Dolan.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 63-74 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,875,334 in view of Kinase et al (4,416,742). Claim 1 of the '334 patent recites a process for anodizing using a solution which contains hydroxylamine, phosphate

anions, a nonionic surfactant, and an alkali metal hydroxide. The solution used in the method of the instant claims contains an alcohol showing at least one alkaline radical group. Triethanolamine is an alcohol falling within the scope of this limitation. Kinase et al discloses that both triethanolamine and hydroxylamine are recognized additives for use in coating baths. It would have been obvious to have utilized triethanolamine in place of the hydroxylamine recited in the claims of the '334 patent because Kinase et al shows them to be equivalent additives.

Response to Arguments

11. Applicant's arguments have been fully considered but they are not persuasive. At page 4 applicant points out that Dolan does not disclose the inclusion of a surfactant in the anodizing solution and notes that Schaedel has been cited for disclosing this feature. Applicant then states that it is preferable if the surfactant added to the solution of the present invention should not create foam because it is intended to work with a bath where the articles to be coated are dipped into it, and any foam would disturb this operation. This argument is not convincing because independent claim 63 broadly recites that the anodizing solution comprises "at least one surfactant". This limitation includes surfactants which tend to foam as well as those that have a more limited or no foaming action. Additionally, claim 63 recites "contacting said metallic surface with an anodizing solution". As written,

the claim includes all ways in which the surface and solution can be brought into contact and is not limited to dipping.

12. With respect to the double patenting rejection, applicant observes that triethanolamine may be one of the alcohols which is used in the present invention for the stabilization of the gel for the polymeric layer, and argues that hydroxylamine would not work as a stabilizer in the solution of the process of the present application. Applicant further argues that the Examiner has not considered the use of the respective components. These arguments are not persuasive because neither a gel nor a polymeric layer is recited in the claims. Thus, the claims are not limited to the specific use argued by applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM T. LEADER whose telephone number is (571) 272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susy Tsang-Foster can be reached on 571-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Harry D Wilkins, III/
Primary Examiner, A.U. 1795

/William Leader/
March 28, 2008